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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
08/702,625	08/23/96	KLUTH H	H1215/1556PC

IM62/0620  
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EXAMINER  
COONEY, J

ART UNIT	PAPER NUMBER
1711	28

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Please find below and/or attached an Office communication concerning this application or proceeding.

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UNITED STATES DEPARTMENT OF COMMERCE  
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**BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES**

Paper No. 28

Application Number: 08/702,625  
Filing Date: 8-23-1996  
Appellant(s): Kluth et al.

\_\_\_\_\_  
Daniel S. Ortiz  
For Appellant

**MAILED**

**JUN 20 2000**

**GROUP 1700**

**EXAMINER'S ANSWER**

This is in response to appellant's brief on appeal filed January 10, 2000.

**(1) *Real Party in Interest***

A statement identifying the real party in interest is contained in the brief.

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**(2) *Related Appeals and Interferences***

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

**(3) *Status of Claims***

The statement of the status of the claims contained in the brief is correct.

**(4) *Status of Amendments After Final***

No amendment after final has been filed.

**(5) *Summary of Invention***

The summary of invention contained in the brief is correct.

**(6) *Issues***

The appellant's statement of the issues in the brief is correct.

**(7) *Grouping of Claims***

Appellant's brief includes a statement that claims 15-36 and 40-68 do not stand or fall together and provides reasons as set forth in 37 CFR 1.192(c)(7) and (c)(8).

**(8) *Claims Appealed***

The copy of the appealed claims contained in the Appendix to the brief is correct.

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**(9) *Prior Art of Record***

The following is a listing of the prior art of record relied upon in the rejection of claims under appeal.

4,263,412	Pauls	4-1981
5,086,175	Minato et al.	2-1992
2,084,698	Schmalsteig et al.	6-1993

**(10) *Grounds of Rejection***

The following ground(s) of rejection are applicable to the appealed claims:

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 15-36, and 40-68 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pauls(4,263,412) in view of Schmalsteig et al.(CA-2,084,698) and Minato et al.(5,086,175)

Pauls discloses preparations of polyurethanes dispensed from a pressure can for dispensing polyurethane foam materials wherein a foam precursor material comprising isocyanate group containing prepolymers, blowing agents, catalysts, and other additives is stored under pressure and foamed upon release (see the entire document).

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Pauls differs from applicants' claims in that it does not particularly specify the removal of residual monomeric isocyanate from its reactive components. However, CA-2,084,698 and Minato et al. (see both documents in their entireties) set forth that the means for removing excess monomer from isocyanate based reactive materials has long been known to the art for the purpose of reducing toxicity. CA 2,084,698 sets forth the more commonly recognized distillation method, and Minato et al. discloses the film evaporation methods. Accordingly, it would have been obvious for one having ordinary skill in the art to have reduced residual monomer contents of the prepolymers placed in the systems of the Pauls reference by the methods set forth by CA-2,084,698 and/or Minato et al. for the purpose of reducing toxicity in order to arrive at the systems, processes, and products of applicants' claims in the absence of a showing of new or unexpected results.

Pauls further differs from claims 66-68 in that it is not concerned with readying its cans for non-toxic disposal by reacting unreacted isocyanate with catalysts and/or polyol. However, these are notoriously well known means of neutralizing isocyanate, and if one had interest in environmental concerns they would have prima facie motivated to make the monetary expense for additional materials to neutralize the isocyanate in the expended packs and ready them for proper disposal. Accordingly, it would have been obvious to use conventional isocyanate neutralizing materials on the residues left in the containers of Pauls for the purpose of rendering the containers biologically safe with the expectation of success in the absence of a showing of new or unexpected results.

**(11) Response to Argument**

Appellants' argue that the references are from non-analogous art. It is maintained that the determination that a reference is from a nonanalogous art is twofold. First, it is decided if the reference is within the field of the inventor's endeavor. If it is not, then it must be determined

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whether the reference is reasonably pertinent to the particular problem with which the inventor was involved. *In re Wood*, 202 USPQ 171, 174; *In re Clay*, 23 USPQ.2d 1058. Disclosures of preparing isocyanate components for polyurethane synthesis having reduced monomeric isocyanate contents is at least pertinent to the endeavors of a referenced inventor who is using isocyanates in preparations of isocyanate components used in prepolymers which are dispensed from cans. The fact that the secondary references may not form foams does not negate their pertinence and relevance to the endeavor of preparing polyurethane products whose fundamental behaviors at a chemical level are not affected by the presence or absence of a blowing agent. Accordingly, it is maintained that an ordinary practitioner in the polyurethane arts would find the teachings of CA-2,084,698 and Minato et al. relevant and pertinent to the teachings of Pauls.

Applicants' maintain that there is no motivation to incur the expenses associated with the combination of references. The fact that these efforts may be expensive relative to their environmental benefits has no bearing on whether motivation is evident. An ordinary practitioner in the art would logically and obviously be directed towards using low toxic monomer containing prepolymers available to him in a prepolymer dispensing system if environmental integrity was at the forefront of his endeavors. Applicants' invention as claimed is utilizing that which is known to the art to the achievement of obvious ends and no invention in a patentable sense is seen. Interest in environmental safety is motivation to avoid toxic materials.

Rejection is maintained as stated above for all claims, and no further arguments concerning individual claims are held to be needed.

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For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

John M. Cooney, Jr.

JMC  
June 19, 2000

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